

## **REMARKS**

### **I. Introduction**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 12 is currently amended. Claims 1-8 are requested to be canceled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 9-12 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

### **II. Response to Issues Raised by Examiner in Outstanding Office Action**

#### **a. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Office Action, page 2. Applicants have amended the claim as suggested by the Office. In light of the amendment, Applicants believe this rejection is moot.

#### **b. Claim Rejections - 35 U.S.C. § 103**

Claims 9-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Ricoh (JP 51104829A) in view of Morishita (US 3,943,063) and Seitz (US 5,169,826).

##### **i. Current Obviousness Standard**

The Supreme Court recently reaffirmed the Graham factors for determining obviousness in *KSR Int'l Co. v. Teleflex Inc.* (No. 04-1350) (U.S., April 30, 2007). The Graham factors, as outlined by the Supreme Court in *Graham et al. v. John Deere Co. of*

*Kansas City et al.*, 383 U.S. 1 (1966), are: 1) determining the scope and contents of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; 3) resolving the level of ordinary skill in the pertinent art; and 4) evaluating evidence of secondary consideration. The Supreme Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a), and held that the proper inquiry for determining obviousness is whether the improvement is more than the predictable use of prior art elements according to their established functions. The Court noted that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed, and specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was ***an apparent reason to combine the known elements in the fashion claimed*** by the patent at issue. To facilitate review, this analysis should be made explicit.

*KSR Int'l Co. v. Teleflex Inc.*, slip op. at 14 (emphasis added). As discussed below, the cited art cannot render the claimed invention obvious.

ii. Ricoh in view of Morishita and Seitz

Ricoh discloses that the microcapsule toner is prepared by mixing an aqueous suspension of core substance (e.g. micro-crystalline wax latex, etc.) with an aqueous solution of the inner-wall material composed mainly of hydrophilic film-forming high-molecular substance (e.g. gum arabic, etc.) to form microcapsules in the aqueous medium, and then adding an aqueous suspension of the outer-wall material composed mainly of a hard resin (e.g. polyvinyl acetate (PVA), etc.), followed by spray-drying of the resulting microcapsule slurry (abstract). As conceded by the Office, Ricoh fails to teach an enteric cellulose derivative as an outer material. Office Action, p. 3.

According to Morishita (US 3,943,063), (a) a polymer suitable as a film forming polymer for a core substance is first dissolved in a solvent (column 7 lines 23-25), (b) a core

substance is dispersed or dissolved in the polymer solution to obtain a dispersion or a solution (column 7 lines 47-49), (c) the polymer solution containing the core substance is added to a vehicle in the presence of a surfactant and dispersed in extremely fine droplets (column 7 lines 58-59 and column 8 lines 38-40), (d) a non-solvent is added to the emulsion of the polymer to precipitate the polymer (column 7 lines 66-67). Examples of the polymer, the solvent, the vehicle and the non-solvent are listed in Table 1. For instance, Example 6 of Morishita describes that aqueous urease solutions are enclosed within polymeric walls of a vinyl chloride-vinylacetate copolymer.

Morishita only discloses the use of a single polymer in any given combination to form the microcapsule with the other components. Consequently, one of skill in the art would not be motivated to utilize the Morishita teachings in the context of Ricoh and the present invention because the methods of Ricoh and the current invention use two distinct kinds of polymer in a distinct methodology for microcapsule formation. Because the methods are different, the disclosure of Morishita cannot be combined with the method of Ricoh.

Morishita also discloses hydroxylpropylmethyl cellulose phthalate (HPMCP) and gum arabic as a film forming polymer (column 4 lines 15 and 17). While the Office indicates that HPMCP would allegedly be an obvious variant as the outer-wall material of Ricoh in the place of PVA, HPMCP can also be used as the inner wall material of Ricoh in the place of gum arabic. As Morishita only utilizes a single polymer, even assuming, *arguendo*, that a person of skill in the art combined the references, a combination of Morishita and Ricoh should lead to the use of HPMCP in the inner coating or both the inner and outer coating. As Applicants have previously provided declaration evidence of the importance of the components and their order of addition, the combination of Ricoh and Morishita does not arrive at the present invention.

Consequently, the above references, even with the addition, of Seitz does not lead one of skill in the art to the present invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

**CONCLUSION**


The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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